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TO: Examiner: E.A. Bolden

FAX NO.: 1-703-872 9311

FROM: COLLARD & ROE, P.C.

RE: U.S. SER. NO. 10/059,833
Group: 1755
Applicants: T. Murata et al

If you do not receive all of the pages, please call the above phone number as soon as possible.

MESSAGE:

Dear Sir:

Enclosed please find a Response to the Office action dated June 11, 2003. Please acknowledge receipt.

Respectfully submitted,

Kurt Kelman

KK:im

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RESPONSE UNDER 37 CFR 1.116
EXPEDITED PROCEDURE
GROUP: 1755

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANTS: TAKAGIII MURATA ET AL EXAMINER: E.A. Bolden

SERIAL NO.: 10/059,833 GROUP: 1755

FILED: JANUARY 30, 2002

FOR: ALKALI-FREE GLASS AND GLASS PLATE FOR A DISPLAY

RESPONSE UNDER 37 CFR 1.116

MAIL STOP AF
Commissioner of Patents
P.O. BOX 1450
Alexandria, VA. 22313-1450

Sir:

This is in response to the Office action of July 11, 2003.

Rejection of claims 1-16 under 35 U.S.C. 103(a) as being unpatentable over Miwa, Kohli or Lautenschlager et, all cited, is respectfully traversed, and a reconsideration of these claims in view of the following comments is respectfully solicited.

The Examiner has conceded that the claims are not **anticipated** under 35 U.S.C. 102(b), as previously held, but has rejected the claims as obvious because the prior art discloses overlapping ranges.

Only Sample Nos. 2, 8 and 9 of Miwa are glasses having a

density of 2.40g/cu.cm or less and a maximum aluminum oxide content of 19%. In all of these glasses, the mol ratio of $(CaO+BaO+SrO)/Al_2O_3$ is much greater than the claimed range of 0.9-1.2. While the general Miwa disclosure and the specific examples noted have overlapping ranges of components, the patent does not direct a person of ordinary skill in the art to make the specific selections claimed herein to obtain the glass product whose advantages have been fully described by applicants. In this respect, applicants respectfully direct the Examiner's attention to the Board of Appeals decision in Ex parte Kuhn, 132 USPQ 360, which approvingly quotes a long line of similar decisions and holds

> "Indeed by selecting specific items and conditions, it might be possible to end up with a product similar to appellant's. However, in the absence of some directions or reasons for making such selection, a very long experimental program might be required in order to arrive at such a product...It therefore appears that appellant has made an invention within the general disclosure of (the reference) and should be entitled to patent protection for his highly specific and limited contribution."

Also believed to be relevant to the issue at bar is In re Schuman et al, 150 USPQ 54, holding that, under 35 U.S.C. 103,

> "References are evaluated by ascertaining the facts fairly disclosed therein as a whole. It is impermissible to first ascertain factually what appellants did and then view the prior art in such a manner as to select from the random facts of that art only that which may be modified and then utilized to reconstruct appellants' invention

from such prior art (emphases by court)."

Applying Kuhn and Schuman et al to the facts herein, applicants have made a "highly specific and limited contribution" by selecting specific ranges for which the prior art gives no "directions or reasons." The prior art may not be viewed "in such a manner as to select from the random facts of that art only that which may be modified." Therefore, the cited law is believed to support applicants' argument for the patentability of the claims under Sec. 103.

Substantially the same arguments as advanced hereinabove apply to the Kohli and Lautenschlager et al glasses. Again, only glasses 8, 11 and 13-16 of Kohli have the claimed upper density limit, and none of these glasses has the claimed minimum content of BaO or mol ratio of $(CaO+BaO+SrO)/Al_2O_3$. All of the glasses exemplified in the Lautenschlager et al patent have a density higher than that claimed by applicants.

To avoid redundancy, applicants incorporate herein the specific comments on the advantages of the claimed invention and the specific differences thereof from the references advanced in the previously filed amendment.

The Examiner's notation that "none of the certified copies of the priority documents have been received" is not

understood. Applicants enclose a copy of the letter mailed May 17,2002 and of the postal card carrying a date of receipt of the priority documents of May 28, 2002. Acknowledgment of this receipt is accordingly respectfully solicited.

A sincere effort having been made to overcome the grounds of rejection, favorable reconsideration and allowance of claims 1-16 are respectfully solicited.

Respectfully submitted,

Takashi MURATA ET AL

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Enclosure: Copy of previous letter

I hereby certify that this correspondence is being sent by telefax to the US PTO, Fax No.: 1-703-872-9311 on October 9, 2003

Ingrid Mittendorf

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